

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Application of:

Arnoud EKKER, et al.

Serial No. 09/353,625

Group Art Unit: 3692

Confirmation No. 3873

Filed: July 15, 1999

Examiner: Nga B. Nguyen

For: A REAL-TIME CHARGE CALCULATION SYSTEM

REPLY BRIEF UNDER 37 CFR 41.41

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Examiner's Answer mailed December 24, 2008, having a reply due date of February 24, 2009, Applicants hereby submit this Reply Brief.

This Reply Brief complies with 37 CFR 41.39(b)(2) by requesting the appeal be maintained and addressing the new ground of rejection as set forth in 41.37(c)(1)(vii) and in view of MPEP 1207.03 (e.g., 1207.03-V.B).

This Reply Brief is timely filed on February 24, 2009, entry of which is requested.

If any further fees are required in connection with this filing, please charge our Deposit Account No. 19-3935.

A Request for Oral Hearing is resubmitted herewith.

I. STATUS OF CLAIMS (37 CFR § 41.37(c)(1)(iii))

Claims 1-34 are currently pending. Claims 1-34 stand finally rejected and are appealed.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 CFR §41.37(c)(1)(vi))

Claims 1-20, 23-29 and 31-33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,377,938 (Block), claims 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Block in view of U.S. Patent No. 6,058,170 (Jagadish) and claims 30 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Block.

III. ARGUMENT (37 CFR § 41.37(c)(1)(vii))

It is respectfully submitted that the remarks in the Appeal Briefs filed on May 10, 2006 and November 24, 2008 and the Reply Briefs filed June 20, 2007 and October 23, 2007 are sufficient to respond to the outstanding rejections. However, the following additional comments are submitted to address the Examiner's New Grounds of Rejection.

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Applicants respectfully submit that this Reply Brief addresses each new ground of rejection in compliance with 37 CFR 41.37(c)(1)(vii) to maintain the appeal.

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Examiner's New Grounds of Rejection

In the Examiner's Answer dated December 24, 2008, the Examiner rejected claims 1-10, 25, 26, 30, 31, 33 and 34 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The Examiner also issued another Communication dated February 12, 2009 also rejecting claims 1-10, 25, 26, 30, 31, 33 and 34 under 35 U.S.C. § 101.

With respect to the § 101 rejections, the Examiner's Answer dated December 24, 2008 and the Communication dated February 12, 2009 appear to be identical. For example, see pages 5 and 6 of the Examiner's Answer dated December 24, 2008 and pages 2 and 3 of the Communication dated February 12, 2009. Applicants respectfully submit that rejections in both Actions are addressed below.

The Applicants respectfully traverse the Examiner's new rejections. Claim 1, for example, is directed to an event pricing system having at least one computer. As the event pricing in the system is performed using at least the computer, the system is apparently tied to a machine, which is within the statutory subject matter. Further, the invention of claim 1 calls for an event pricing "system" including determining whether "a system initiated" and created non-usage event independent of user initiated events is due, thus complying with USPTO's current 35 USC 101 statutory subject matter requirement by expressly tying the claim to a particular apparatus (i.e., "**a computer**" and "**a system**"). See also independent claims 25, 26 and 31 having similar recitations.

By way of example, claim 1 recites, "determining whether a system initiated and created non-usage event independent of user initiated events is due to be created" and "pricing the system-created non-usage events and non-system-created events as they become available to the system." As such, the pricing is achieved when events are created and the pricing information is transformed (i.e., changed) based on determination of whether the events are created. In other words, events are created and "pricing" is tied to "an article." That means that the claimed process is tied to something real (i.e., viewable data), and cannot be an idea or concept separated from or floating above or apart from real things.

Applicants also submit that the independent claims call for transforming an applicable event into a pricing event. Accordingly, the underlying subject matter (the event) is transformed to a different state or thing (a bill). The event is changed when priced and billed.

The recent decision of In re Bilski, 88 USPQ2d 1385 (Fed. Cir. 2008), particularly defines that the proper test for whether the claim as a whole is statutory subject matter is the machine-or-transformation test. "A claim that is tied to a particular machine or brings about a particular transformation of a particular article does not pre-empt all uses of a fundamental principle in any field but rather is limited to a particular use, a specific application."

In re Bilski further clarifies that a claim directed to the transformation of "data", with the data being the article, can be statutory, implying that such a claim should still give some explanation of the particular type or nature of the data, how or from where the data was obtained, or what the data represented. See the In re Bilski decision at page 25-26.

Thus, according to In re Bilski, the "article" aspect of the machine-or-transformation test is not limited to physical devices or compounds, and specifically not limited to something that would fall within a statutory class. For example, an article can be something that is

representative of a physical (or physically observable) object or substance. See the In re Bilski decision at page 26.

As only an example, independent claim 1 recites the alteration of the data pertaining to pricing of events "as they become available to the system", which is different (altered) from just seeing the data itself (i.e., prior to the pricing of the events). Data of the event is changed during pricing and billing.

Thus, as an example, independent claim 1 clearly meets both the transformation portion and the machine portion of the machine-or-transformation test. Therefore, as the other rejected claims either recite similar features or depend from independent claims which recite similar features, the Applicants respectfully submit that the claims satisfy the requirements of 35 U.S.C. §101, and further respectfully request the withdrawal of the Examiner's §101 rejections of these claims.

With respect to claims 30, 33 and 34, according to In re Bilski, "The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfied §101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article," In re Bilski, 88 USPQ2d 1385, 1396.

The language of claim 30 recites that a state of the "system initiated and created non-usage events" is transformed into another state by "pricing the events."

Similarly, claim 33 recites that information of a bill is transformed "using a computer" by "continuously reflecting the event independent of the user's initiation on the bill." For example, the information of the bill is altered and transformed when information of the events are reflected thereon. Claim 33 also recites use of a "computer for real-time calculation of a bill", where the bill including the event independent of the user's initiation is "displayed to the user."

The claimed "continuous bill calculation using a computer" (claim 34), specifies the type or nature of the data, which in turn are representative of physical and tangible objects, namely "a non-usage event and a usage event initiated by a user". And the information of "the pricing for the non-usage event and the usage event" is transformed into different states, providing a practical application to transform specific data. See In re Bilski, 88 USPQ2d 1385, 1397.

For at least the reasons stated above, it is respectfully submitted that claims 30, 33 and 34 also at least comply with the transformation portion of the 'machine-or-transformation' test.

A prima facie case of unpatentability under 35 USC 101 cannot be established, because it is not more likely than not (i.e., by preponderance of evidence burden of proof - 37 CFR 1.56) that the claimed invention as a whole falls outside of one of the enumerated statutory classes in view of In re Bilski.

Reversal of the Examiner rejection is requested.

Examiner's Response To Argument

On pages 4-15 of the Communication mailed February 24, 2009 and on pages 6-18 of the Examiner's Answer mailed December 24, 2008, the Examiner repeats previously addressed arguments.

In item (10) of the Examiner's Supplemental Answer mailed December 24, 2008, the Examiner essentially repeats item (11) of the Examiner's answer mailed April 20, 2007 and item (10) of the Examiner's Supplemental Answer mailed August 23, 2007.

Specifically, the Examiner asserts that col. 7, lines 55 through col. 8, line 6, teaches "pricing system-created non-usage events and non-system-created events as they become available" and "independent of a billing process", as recited in claim 1.

Block only relates to calculation of charges in real time *during* a call where "The Processor 60 calculates call charges in real time during a call, applying the duration of the call to the appropriate section of the tariff stored in the Tariff Memory 76." The prepaid system of Block would be inoperative if call charges were computed (priced) but not charged (billed) at the same time as the call, since the Block system would not be able to make a determination of whether the user has a sufficient balance based on the account information. As such, Applicants respectfully maintain that Block only discusses call charge pricing that is integral to billing.

The Examiner also appears to imply that the Specification describes the non-usage event independent of user initiated events as recurring event discussed on page 11, lines 10-16. Applicants respectfully submit that the Specification also discusses system created events such as minimum charge summary, maximum charge summary, etc. (see, page 15, 1st full paragraph; page 18, first paragraph).

Block does not teach or suggest the claimed features as set forth in the independent claims. Accordingly, Block does not disclose every element of the Applicants' claims. Therefore, since Block does not disclose the features recited in the independent claims, as

stated above, it is respectfully submitted that the independent claims patentably distinguish over, and withdrawal of the §102 rejection is earnestly and respectfully solicited.

Jagadish is limited to generating an automatic message accounting (AMA) record when a customer places calls (see, FIG. 2 and corresponding text).

All previously filed arguments are incorporated herein.

Therefore, it is respectfully submitted that the claimed invention is patentably distinguishable over the cited references.

IV. CONCLUSION

For the reasons set forth above, it is submitted that the Examiner's Answer does not rebut the arguments presented in the Appeal Briefs, Reply Briefs and during prosecution of the present application.

Therefore, it is respectfully submitted that the Examiner's final rejection of the claims is without support and erroneous. Accordingly, the Board of Patent Appeals and Interferences is respectfully urged to so find and to reverse the Examiner's final rejection.

If any additional fees are required in connection with the filing of this Reply Brief, please charge same to our Deposit Account No. 19-3935.

Respectfully submitted,

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V. CLAIMS APPENDIX (37 CFR § 41.37(c)(1)(viii))

1. (PREVIOUSLY PRESENTED) An event pricing system, comprising:
at least one computer having:
a continuously running event creation process determining whether a system initiated and created non-usage event independent of user initiated events is due to be created and creating the non-usage event; and
a continuously running pricing process pricing the system-created non-usage events and non-system-created events as they become available to the system, where the pricing process includes pricing the system-created non-usage events and/or the non-system-created events independent of a billing process.
2. (ORIGINAL) A system as recited in claim 1, wherein all events are priced as they become available to the system.
3. (ORIGINAL) A system as recited in claim 1, wherein all system-created events are created at any time based on a flexible schedule independent of a billing process.
4. (PREVIOUSLY PRESENTED) A system as recited in claim 3, wherein system initiated and created events for a customer may be created in one of less frequently than the customer is billed, as frequently as the customer is billed and more frequently than the customer is billed.
5. (ORIGINAL) A system as recited in claim 1, wherein summary events are created and maintained in real-time as events are priced.
6. (ORIGINAL) A system as recited in claim 1, wherein all events are available for contribution to summary records for discounting and consolidation.
7. (ORIGINAL) A system as recited in claim 1, wherein charges for all events that are relevant to a billing period are calculated and available in the system at the earliest practical time.
8. (ORIGINAL) A system as recited in claim 1, wherein processing for calculating charges to be billed in a current billing period is outside the billing process.

9. (ORIGINAL) A system as recited in claim 1, wherein charges for all unbilled events are ready for the billing process and ready for display on-demand.

10. (ORIGINAL) A system as recited in claim 1, wherein said pricing process performs real-time recalculation of a charge for any unbilled event when information in the system which impact the charge has changed.

11. (PREVIOUSLY PRESENTED) A computer implemented event pricing process, comprising:

determining, by a computer, whether a system initiated and created non-usage event independent of user initiated events is priceable; and

pricing, by the computer, the non-usage event responsive to the determining, where the pricing includes pricing the non-usage event independent of a billing process that includes a non-system-created event.

12. (PREVIOUSLY PRESENTED) A process as recited in claim 11, wherein priceable events are priced immediately.

13. (ORIGINAL) A process as recited in claim 11, wherein all charge events are priced in real-time.

14. (PREVIOUSLY PRESENTED) A computer implemented event pricing process, comprising:

determining, by a computer, whether an event is priceable; and

pricing, by the computer, the event responsive to the determining, wherein all available system initiated and created non-usage events independent of user initiated events for a current billing period are priced at a first opportunity after a prior billing period that includes non-system-created events ends.

15. (ORIGINAL) A process as recited in claim 11, wherein a usage event is priced at a time that the usage occurs.

16. (ORIGINAL) A process as recited in claim 11, wherein a recurring charge is

calculated after an end of a prior billing period and before the billing date for the recurring charge.

17. (ORIGINAL) A process as recited in claim 11, wherein a minimum or a maximum charge is calculated and captured in a summary after an end of a prior billing period and before the billing date for the recurring charge.

18. (ORIGINAL) A process as recited in claim 11, wherein charges for summary events are calculated on-demand at a time of charge display.

19. (PREVIOUSLY PRESENTED) A computer implemented event pricing process, comprising:

determining, by a computer, whether a system initiated and created non-usage event independent of user initiated events is due to be created; and

creating, by the computer, the non-usage event responsive to the determining; and

pricing, by the computer, the non-usage event responsive to the creating, where the pricing includes pricing the non-usage event independent of a billing process that includes a non-system-created event.

20. (PREVIOUSLY PRESENTED) A process as recited in claim 19, wherein system initiated and created events are created independent of other processes.

21. (PREVIOUSLY PRESENTED) A process as recited in claim 19, wherein system initiated and created events are created according to a schedule in the system.

22. (ORIGINAL) A process as recited in claim 21, wherein said schedule is created and maintained by the system based on subscription information available in the system.

23. (ORIGINAL) A process as recited in claim 19, wherein a recurring event is created after an end of a prior billing period and before the billing date for the recurring charge.

24. (ORIGINAL) A process as recited in claim 19, wherein minimum and maximum charge summary events are created after an end of a prior billing period and before the billing date for the recurring charge.

25. (PREVIOUSLY PRESENTED) An event pricing system, comprising:

a computer having:

a continuously running event creation process determining whether a system initiated and created non-usage event independent of user initiated events has become current; and

a continuously running pricing process pricing the system-created non-usage events and non-system-created events as they become available to the system, and creating and maintaining summary events in real-time as events are priced, where the pricing process includes pricing the system-created non-usage events and/or the non-system-created events independent of a billing process.

26. (PREVIOUSLY PRESENTED) An event pricing system, comprising:

a computer having:

a continuously running event creation process determining whether a system initiated and created non-usage event independent of user initiated events is due to be created and creating system-created non-usage events at any time based on a flexible schedule; and

a continuously running pricing process, independent of a billing process, pricing of the system-created, non-usage and non-system-created events as ready for the billing process and for display as they become available to the system with all events priced as they become available to the system and creating summary events as events are being priced and performing real-time recalculation of a charge for any unbilled event when information in the system which impacts charge has changed.

27. (PREVIOUSLY PRESENTED) An event pricing apparatus, comprising:

a source of system initiated and created non-usage events independent of user initiated events; and

a processor pricing the non-usage events when the events are priceable, where the pricing includes pricing the non-usage event independent of a billing process that includes the user initiated events.

28. (PREVIOUSLY PRESENTED) A computer readable storage medium including an event pricing process controlling a computer and having a continuously running event creation process determining whether a system initiated and created non-usage event independent of user initiated events is due to be created, and a continuously running pricing process pricing the

system-created non-usage events and non-system-created events as they become available to the system, where the pricing process includes pricing the system-created non-usage events and/or the non-system-created events independent of a billing process.

29. (PREVIOUSLY PRESENTED) A system providing pricing information for on-demand billing for events, comprising:

- a message queue receiving events including system initiated and created non-usage events and usage events; and

- a processor performing a pricing process where non-usage and usage events independent of user initiated events are continuously delivered to the pricing process via the message queue and priced as they become available independent of a billing process.

30. (PREVIOUSLY PRESENTED) A continuous pricing process for an event-driven system, comprising;

- storing events in a message queue, the events being system initiated and created non-usage events, usage events, one time events, and summary events;

- delivering the events in the message queue to a pricing process as they become available, the delivered events including events independent of user initiated events; and
- pricing the events, the pricing including pricing the non-usage events independent of a billing process that includes the user initiated events.

31. (PREVIOUSLY PRESENTED) An event pricing system, comprising:

- at least one computer having:

- a continuously running event creation process determining whether a system initiated and created non-usage event independent of user initiated events is due to be created and creating the non-usage event when due;

- a continuously running pricing process pricing the system-created non-usage events and non-system-created events including usage events as they become available to the system producing priced events, the pricing process including pricing the system-created non-usage events and/or the non-system-created events independent of a billing process; and

- an intermittently running billing process running responsive to bill cycles and customer on demand billing information requests and producing a bill using the priced events.

32. (PREVIOUSLY PRESENTED) An event pricing process using a computer,

comprising:

receiving system initiated and created non-usage events independent of user initiated events; and

pricing, by the computer, the system initiated and created non-usage events as soon as the events are received, where the pricing includes pricing the non-usage events independent of a billing process that includes the user initiated events.

33. (PREVIOUSLY PRESENTED) A method for a continuous real-time calculation of a bill using a computer, comprising:

executing the real-time calculation of the bill each time an event independent of a user's initiation occurs, the processing of the real-time calculation of the bill being independent of a billing process having an event responsive to the user's initiation; and

continuously reflecting the event independent of the user's initiation on the bill and maintaining a summary total for the bill, where the bill including the event independent of the user's initiation is displayed to the user on-demand and/or is provided to the user in accordance with the billing process.

34. (PREVIOUSLY PRESENTED) A method of continuous bill calculation using a computer, comprising:

determining whether a non-usage event independent of a user initiated event and a usage event initiated by a user are available for pricing; and

executing the pricing for the non-usage event and the usage event based on determination of availability for pricing, where the non-usage event is available for pricing at a first billing period and the usage event is available for pricing at a second billing period.